

REMARKS / ARGUMENTS

Remaining Claims

Claim 1, 3-10, 12-34 and 48-55 remain pending in this application. Applicants have amended claims 1, 3, 8, 9, 13, 14, 31, 34 and cancelled claims 2 and 11.

Rejection under 35 U.S.C. 112

The Examiner rejected claim 1 for an informality. Applicants have amended this claim. The Examiner also rejected claims 10 and 12-34 for being indefinite for lack of antecedent basis. Applicants amended claim 34 independent claim 1. Applicants respectfully request that these rejections be reconsidered and withdrawn.

Rejections under 35 U.S.C. 103 (a)

The Examiner withdrew earlier allowability of the claims in view of EP 0 131 227. For these reasons, Applicants direct their comments and traverse to the use of EP 0 131 227 as a primary reference.

Primarily, MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggested the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Accordingly, the Examiner is required to show a motivation to combine these references. The EP reference does not suggest a motivation to combine with the previously cited references. Moreover, the previously cited references do not suggest a motivation to combine. The EP reference, in fact, teaches away from the combination.

Specifically, the EP reference is directed to polymerized film that is cut via stamping two components together. The stampable film is the exact weight that is needed for the final product. Hence, there is certainly no suggestion, nor a need to combine this with a reference like Yang, to achieve "having a variable volume between a first volume and a second volume, the second volume being greater than the first volume, wherein the mold parts have sufficiently small clearance such that gas escapes from the mold cavity and none of the polymer escapes

from the mold cavity.” Such a combination is improper according to MPEP section 2145 X.D.2. “It is improper to combine references where the references teach away from their combination.” *In re Grasselli*, 713 F.2d 731.743, 218 USPQ 769,799 (Fed. Cir. 1983).

The Examiner has sought to combine the EP reference with Yang in each and every 103 rejection. Such combination is improper as there is no teaching or suggestion to combine, in light of the fact that the EP reference teaches away from a combination with Yang.

Conclusion

In view of the foregoing amendments, and comments, Applicants submit that the 35 USC § 112 and 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not anticipated by or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action.

Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned. Please address all correspondence to Robert Gorman, CIBA Vision, Patent Department, 11460 Johns Creek Parkway, Duluth, GA 30097. The Commissioner is hereby authorized to charge any other fees which may be required under 37 C.F.R. §§1.16 and 1.17, or credit any overpayment, to Deposit Account No. 50-2965.

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Respectfully submitted,



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